

BUSINESS BRIEF: PAKISTAN

How do you register or secure patent rights, and is national or international coverage most appropriate?

Patent rights are governed by the Patents Ordinance, 2000, along with the Patents Rules, 2003. Upon filing an application, it is examined and, once all the objections of the examiner are met, it is accepted. After acceptance, it is published for opposition. If no opposition is filed within four months of publication, the sealing fee is paid and the Letters Patent Document is issued. This grant of exclusive rights is for 20 years, subject to yearly renewal after the expiry of the fourth year from its grant date.

The right granted under the Patents Ordinance is valid for Pakistan only and Pakistan is not a member of Patent Cooperation Treaty.

What are the costs for obtaining a patent, and what are the costs of defending it?

The approximate official charges from filing till grant of a patent, excluding opposition, come to \$57. These are basic charges that may increase due to additional pages or claims in the initial application, or if a number of examination reports are issued. There are no official charges for formalities in relation to opposition except for extensions if needed, while official charges for each hearing are \$9.

Where can you find information on existing patents in your jurisdiction (i.e. online database, patent office request, etc.)?

The IPO Pakistan has a website at www.ipo.gov.pk, providing online search of existing patents, while published applications in the *Official Gazette* provide basic information about inventions. For detailed information, a request should be filed with the patent office.

Is there anything unusual about the patent law that companies should be aware of—what are the most common mistakes businesses make?

The existing law requires unity of invention and it does not provide protection to a group of inventions. Second use claims are not allowed. Inventions relating to a chemical product intended for use in agriculture or medicine protection of derivatives and salts are not patentable. Claims directed to method of medical treatment and use/Swiss use claims are also not allowed.

The most common mistakes made by patent owners are non-use leading to infringement and not taking timely action against infringers.

What are the key threats to patent owners, and what is the best strategy if you suspect someone is infringing your patent?

Infringement is one of the key threats to patent owners and, in the case of infringement, the rights holder has the option to initiate a civil action against an infringer. The rights holder may initiate a suit for infringement against any person who during the validity of the patent, makes, sells or uses the invention without his licence, or counterfeits it, or imitates it. The suit may be filed in a district court with jurisdiction to hear the case. In any suit for infringement, the court can grant relief by way of damages or injunctions.

Trademarks

How do you register or secure trademark rights and what protection does it grant?

Trademark rights may be secured by filing an application on a prescribed form at the Trade Marks Registry. For non-Pakistanis, it is mandatory to file the application through a local trademark agent. The application is examined and

if objections are overcome, the mark is published in the *Trade Marks Journal* for opposition purposes. If no opposition is filed, then the mark proceeds to registration. Registration is granted for a term of 10 years and may be renewed every 10 years. Trademark protection grants the proprietor an exclusive right to use the mark and the statutory right (instead of a common law right) to bring an action against an infringer.

What are the costs for registering a trademark, and what are the costs of defending it?

The approximate official charge for registering a trademark, all the way from filing until registration, is \$48 in a single class, excluding extensions and oppositions. The official charge for defending a mark in the case of opposition proceedings would be \$9 without extensions.

What are the key threats to trademark owners and what is the best strategy for dealing with infringement?

Key threats to trademark owners include infringement, passing-off, counterfeiting and piracy, as well as rectification of the mark. Infringement can take many forms and is the gravest threat. It is crucial to have a holistic, proactive and robust trademark protection strategy, and it is also vital to take the necessary steps as soon as the need arises. Furthermore, it is advisable to immediately seek legal counsel in order to devise an effective strategy to counter the menace of infringement. As a pre-emptive measure, it is always best to register one's trademark in a timely fashion.

What are the most common mistakes trademark owners make?

Trademark owners sometimes assume that they must commence use of their trademark prior to applying for registration (even though

there is no such requirement) and, as a result, the mark owners sometimes fail to register their marks promptly.

Despite being aware, many trademark owners are very laid back when it comes to conducting periodic market surveys and are not vigilant enough in terms of keeping a check on infringement activities. Furthermore, even when they become aware of some such activity, they do not act swiftly and effectively, and this not only encourages the infringers to continue their illicit activity, but also encourages others to do so.

Non-use of the mark also poses a threat to the trademark owner because if the proprietor of the mark does not use the mark within five years from the date when it is actually put on the register, then any third person may file an application for cancellation of the mark.

Counterfeiting

How big a problem is counterfeiting in your jurisdiction? What industries are particularly at threat?

Counterfeiting is an enormous problem. Many sectors are affected by counterfeiting and piracy of goods, but the most affected area is, unfortunately, the pharmaceutical industry. The entertainment industry is also gravely threatened, and pirated CDs and DVDs of music and films are easily available. Likewise, the confectionary industry is also affected by rampant counterfeiting.

What are the best strategies for dealing with the problem?

The best strategy to deal with this problem is to seek legal counsel as soon as the problem arises in order to ascertain how best to safeguard your IP rights. If counterfeit goods are being imported or exported, it is a good idea to notify the customs department as it may exercise its

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power to confiscate the suspected goods. In some situations, it is also appropriate to issue a public notice in a few leading local newspapers to make people aware of counterfeit products in the market. ■

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Hameeda Asif did her master's degree in biochemistry and is presently studying law at S.M. Government Law College, Karachi. She joined Bharucha & Co. in April 2005 as a trainee in the patents department and is now qualified to be a patent agent. She is primarily involved in dealing with matters relating to patents and industrial design, and in particular, she looks after searches, examinations and opposition matters. Asif has extensive experience in advising national and international clients in both legal and technical matters, especially relating to pharmaceutical, chemical and biotechnological sectors.



Ayesha Hasan obtained her LLB degree from the University of London and is currently working as an associate at Bharucha & Co. She has been practising as an IP lawyer for more than two years, specifically in aspects related to trademark matters. She deals with searches and correspondence with national and international clients. She also assists senior attorneys in specific projects.